APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,207	07/22/2003	Ronald Wrenholt	20030242.ORI	7047

23595 7590 10/17/2005		EXAMINER
NIKOLAI & MERSEREAU, P.A.		DEBROW, JAMES J
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SUITE 820	ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402	2176	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/624,207	WRENHOLT ET AL.
Office Action Summary	Examiner	Art Unit	
	James J. Debrow	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22July2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22July2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Application filed on 22 July 2003.

2.   Claims 1-10 are pending in this case. Claim 1 is an independent claim.

Specification

3.   Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because applicant uses the term

"publisher's computer". The terminology is not accurate- "publisher" refers to what kind

of entity owns the computer. It is very clear from the specifications that a "publisher's

computer" can be virtually any personal computer. This term is also used within the

specification and appropriate actions should be taken. Applicant did not state that

applicant was acting as his own lexicographer. Further, even if applicant elects to act as

his own lexicographer, applicant cannot arbitrarily redefine terminology far from the

standard grammatical and etymological basis from the term, which is not the term

applicant uses. (See American Heritage College Dictionary', most recent edition.)

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to independent claim 1, in section g of this claim, applicant uses the term "said computer". It is not clear as to which computer the applicant is referring to, the first computer or the second computer, as both were previously mentioned in this claim. Clarification is required in this matter.

With respect to dependent claims 2-10, they are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.1   **Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Popa et al. (U.S. Patent No. 5,991,783; Date of Patent: Nov 23, 1999), in view of

Nakai et al. (Pub. No.: US 2004/003411 A1; Pub. Date: Jan. 1, 2004; Effective Filing

Date: Jun. 28, 2002).

        With respect to independent claim 1, Popa et al. **discloses** a computer

system *(first computer)* and method for generating, storing, and transmitting graphical

images. Usually, the images are computer-generated, scanned from a photo, or

scanned using an electronic camera, and *stored* as a graphics file in data storage.

Popa et al. uses a module called a Graphics Manipulator for communicating with the

graphical image database when modifications are required. These modifications, which

are executed from instructions that are provided from user input devices such as a

keyboard and mouse, can include *cropping* an image, rotating all or parts of an image,

duplicating all or parts of an image, sharpening an image, blurring an image, adjusting

the image resolution, color correcting, and adding text/*data* to an image (16 in Fig 1;

column 5, lines 4-10). The Graphics Manipulator contains a master data file generator

(34 in Fig 1) for generating and storing in the data storage (12 in Fig 1), a master data

file *(panel)* that contains the modified graphical data/images (110 in Fig 5, column 5,

lines 14-16). The master data file *(panel)* contains a *low-resolution version of the image*

(thumbnail/preview image) (50 in Fig 2a), along with a *high-resolution version of the*

image. The *high-resolution version of the image* enables the user to see the image on

the computer screen for positioning, *grouping*, and/or modifications. The graphical

data/image file can be stored in either RAM, hard disk, floppy disk, or compact. Popa et

al. computer system *(first computer)* also contains a *Layout Page* Creator Module (18 in

Fig 1), which is capable of combining text and graphical images stored in data files in

accordance with instructions inputted the user to generate a layout page (column 5,

lines 29-32; column 8, lines 49-52). Once the user has completed laying out the various

elements of the layout page, the Layout Page Creator generates and stores a layout

page data file containing the various formatting instructions. The *modified* layout *page*

file is sent to a Spooler Module (20 in Fig 1) before it is transmitted to the printer for

printing. The Spooler receives just the thumbnail/preview files *(low-resolution version of*

the image), which increase the speed of transmission of the file to the printer and frees

up the computer for further work.

Popa et al. **does not disclose expressly** *using one of a plurality of second*

computer at location remote from said first computer system to access said database.

However Nakai et al. **discloses**, an imaging service system, which includes a

plurality of user computers/terminals *(second computer)*, and a network server (section

0041, lines 8-10; Fig 1). The user computers/terminals (8-1 thru 8-M in Fig 1) and

network server (10 in Fig 1) are connected via the Internet (N in Fig 1) to the router (12

in Fig 1). The user computers/terminals has remote access to the local server, where

graphical images are stored, via the network server. The local server is capable of

transmitting images that are selected by the user from images displayed on the display

device via the network to the user computer/terminal (section 0018). At the time of the

invention, it would have been obvious to a person of ordinary skill in the art to combine

Nakai et al. and Popa et al. for the benefit of customers to remotely access images that

are stored on the publisher's computer for positioning and modifying the images of their

publication.

With respect to dependent claim 2, Popa et al. **discloses** a layout page

creator that is capable of combining text and various graphical images (column 5, lines

29-30). It would have been inherent that the same data used to create descriptions for

the photographs, could also be used to create captions.

With respect to dependent claims 3-6, Popa et al. **does not disclose**

expressly that the images and data created/stored by his invention could be used to

form a publication such as a yearbook, directory, calendar, or a special event

publication.

However, Nakai et al. **discloses**, his invention can be designed to create an

electronic photo album consisting of images selected from the stored images (section

0066). He also states his invention can be designed to create an album of events such

as birthdays (section 0068). At the timer of the invention, it would have been obvious to

a person of ordinary skill in the art to combine Nakai et al. with Popa et al. for the benefit

of using stored image files, along with their related data files, to create publications such

as a yearbooks, directories, calendars, and of special events.

With respect to dependent claim 7, Popa et al. **discloses** one aspect of his

invention as a computer readable storage medium where a file of images are stored in

one format, and another file of the images are stored in second format (column 2, lines

45-51; column 3, lines 20-26). The first file includes a pointer that points to the second

file, wherein both files behave as a single file. Using the broadest definition of a

relational database, in which one database table/file is a component of another

database table/file, the examiner determined that the database used by Popa et al. to

store image and data files, is a relational database.

With respect to dependent claim 8, Popa et al. **discloses** the said images are

photographs (column 6, lines 26).

5.2   Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popa et al. (U.S. Patent No. 5,991,783; Date of Patent: Nov 23, 1999), in view of Nakai et al. (Pub. No.: US 2004/003411 A1; Pub. Date: Jan. 1, 2004; Effective Filing Date: Jun. 28, 2002), and further in view of PrePRESS (PrePRESS Technology Reports, "Open Prepress Interface(OPI)")('Prepress').

With respect to dependent claims 9 and 10, Popa et al. **discloses**, a user is allowed to perform necessary positioning and cropping adjustments to the thumbnail/preview *(low-resolution image)* images displayed on the computer screen (column 8, lines 60-64).

Popa et al. **does not disclose expressly** *cropping values and scaling values indicated on the low-resolution images are applied to the high-resolution images as part of the step of changing the low-resolution images to high-resolution images.*

However, Prepress **discloses,** the appearance of the high-resolution image can be changed by manipulating the preview image *(the low-resolution image).* For instance, the preview image can be cropped, scaled, or rotated, and the high-resolution image will reflect those manipulations when imaged (Prepress pg. 11, 3rd paragraph). At the timer of the invention, it would have been obvious to a person of ordinary skill in the art to combine Prepress with Popa et al. for the benefit of having the cropping and scaling modifications that the user apply to the preview image (low-resolution) from the second computer to automatically be applied to the high-resolution image that is stored on the first computer.

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to James J. Debrow whose telephone number is 571-272-
5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

James J. Debrow
Examiner
Art Unit 2176

WILLIAM BASHORE
PRIMARY EXAMINER
10/13/2005